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EXAMINER

ROSSI, JESSICA

ART UNIT PAPER NUMBER

1733

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,855

Applicant(s)

KANO ET AL.

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "34d" has been used to designate both arm 34c and arm 34d in Figure 1. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:

Page 5, line 14: "or the fixing mechanism" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, it recites the limitation "the thermal fusible layer of each disc protective sheet" in line 8. There is insufficient antecedent basis for this limitation in the claim. It is suggested to insert --of each disc protective sheet-- after "an attachment surface" in line 7.

Regarding claim 2, it is unclear as to how the protective sheet can be fixedly fused so that it is provisionally attached. Based on the present specification, provisional attachment and

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fixedly fusing are two separate steps such that fixedly fusing takes place after provisional attachment (p. 5, lines 12-15; p. 24, lines 18-23). Applicants are asked to clarify.

Regarding claim 2, it recites the limitation "the preceding step of fixedly fusing the entire surface of the disc protective sheet" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim, since claim 1 does not set forth fusing the entire surface of the protective sheet.

Regarding claim 2, it recites the limitation "the thermal fusible layer of the peripheral edge portion of the cut portion" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "the peripheral edge portion" to --a peripheral edge portion--.

Regarding claim 2, it recites the limitation "the peripheral edge portion of the opening portion" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this to --a peripheral edge portion of the opening--.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Howey et al. (US 5582901).

With respect to claim 1, Howey is directed to attaching a disc protective sheet to each half body section of a magnetic disc cartridge (note disc rotates within cartridge; column 4, lines

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43-44). The reference teaches supplying liners 30, 32 each comprising disc protective sheet 100 and thermal fusible layer 120 to each half body section 12, 14, respectively (Figures 1-2; column 4, lines 40-41 and 49-51). The reference teaches each liner being oriented so that cut-outs 34, 36 therein are aligned with a corresponding opening 18 in each half body section and so that the thermal fusible layer 120 provided on an attachment surface 115 of each protective sheet faces the half body section (column 4, lines 53-54; column 5, lines 2-7). The reference also teaches fixedly fusing the thermal fusible layer onto an inner surface of each half body section (column 4, lines 60-63).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Howey (US 6075682).

Based on the present specification, it appears Applicants invention is directed to the thermal fusible layer being in direct contact with the surface of the protective sheet. Therefore, the rejection set forth below is intended to expedite prosecution.

With respect to claim 1, Howey '682 is directed to attaching a disc protective sheet to each half body section of a magnetic disc cartridge (note disc rotates within cartridge). The reference teaches supplying liners 10/50 each comprising a disc protective sheet 14 and thermal fusible layer 12 to each half body section 32, 34, respectively (Figures 2A, 5; column 3, lines 1-27; column 5, lines 20-21 and 29-30). The reference teaches each liner being oriented so that

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cut-outs 44, 46 therein are aligned with a corresponding opening 38 in each half body section and so that the thermal fusible layer 12 provided on an attachment surface of each protective sheet faces the half body section (column 5, lines 29-35). The reference also teaches fixedly fusing the thermal fusible layer onto an inner surface of each half body section (column 5, lines 39-45).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kunio (JP 60-136981) in view of Ozawa (JP 3-176881).

With respect to claim 1, Kunio is directed to attaching a disc protective sheet to each half body section of a magnetic disc cartridge 1 (note disc rotates within cartridge). The reference teaches supplying a liner 10 comprising disc protective sheet 11 and thermal fusible layer 12 to each half body section 2, 3 with the liner being oriented so that cut-outs therein are aligned with corresponding openings in the half body sections and so that the thermal fusible layer provided on an attachment surface of the protective sheet faces the half body sections (Figures 1-3; abstract; oral translation). The reference teaches fixedly fusing the thermal fusible layer onto an inner surface of each half body section (p 2, 2nd column). However, the reference is silent as to a separate liner being attached to each half body section.

It is known in the art to form a magnetic disc cartridge by attaching liners 31, 32 to the inner surfaces of separate half body sections 21, 22, respectively, and attaching the half body sections to each other to form the disc cartridge, as taught by Ozawa (Figures 1-3; abstract; oral translation). The reference teaches the liners being non-woven and comprising multiple layers (Figures 2-3; abstract; oral translation).

One reading Kunio as a whole would have appreciated that the reference is concerned with the manner in which the liner is bonded to the inner surfaces of the cartridge and not the manner in which the cartridge halves are assembled to each other to form the finished product. Therefore, it would have been obvious to the skilled artisan at the time the invention was made to provide the half body sections of Kunio as separate halves and provide the liner of Kunio as separate liners to each half body section because such is an alternative method for assembling magnetic disc cartridge halves, as taught by Ozawa, wherein this allows for manufacturing the parts for one cartridge at multiple workstations.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kunio and Ozawa as applied to claim 1 above, and further in view of Sato (JP 63-258361).

Regarding claim 2, Applicants are directed to paragraph 10 above for a complete discussion of Kunio and Ozawa. Kunio teaches fixedly fusing the entire surface of the liner with respect to the half body sections (oral translation). The reference is silent as to provisional attachment of the liner.

It is known in the art to provisionally attach a disc protective sheet to a half body section of a disc cartridge followed by fixedly fusing the same thereto wherein provisional attachment allows for accurate placement of the liner during processing, as taught by Sato (abstract).

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Therefore, it would have been obvious to the skilled artisan at the time the invention was made to provisionally attach the liner of Kunio because such is known in the art, as taught by Sato, and this allows for accurate placement of the same during processing.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-9 of copending Application No. 09/595,546 (refer to US 2003/0047274 for claims; note claims in parent case '546 and child case '926 are identical) in view of the collective teachings of Howey '682 and Ozawa.

With respect to claim 1, the copending application teaches all the limitations except the cartridge being a disc cartridge, supplying the liner to each half body section of the cartridge, and the liner having a cut-out aligned with an opening in the half body section.

It would have been obvious to have the cartridge of the copending application be used as a disc cartridge wherein the cartridge and liner are constructed and assembled in the manner claimed by the present invention because such is known in the art, as taught by the collective teachings of Howey and Ozawa, wherein this provides for a well-protected magnetic disc.

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This is a provisional obviousness-type double patenting rejection.

14. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-9 of copending Application No. 09/595,546 in view of the collective teachings of Howey '682 and Ozawa and further in view of Kunio.

Regarding claim 2, the copending application is silent as to fusing the entire surface of the liner to the half body section. The skilled artisan would have been motivated to do so because such is known in the art, as taught by Kunio, wherein this prevents the liner from becoming detached from the half body section.

This is a provisional obviousness-type double patenting rejection.

15. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-9 of copending Application No. 10/285,926 (refer to US 2003/0047274 for claims, which are identical to those presented in 09/595,546) in view of the collective teachings of Howey '682 and Ozawa.

With respect to claim 1, Applicants are directed to paragraph 13 above.

This is a provisional obviousness-type double patenting rejection.

16. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-9 of copending Application No. 10/285,926 in view of the collective teachings of Howey '682 and Ozawa and further in view of Kunio.

Regarding claim 2, Applicants are directed to paragraph 14 above.

This is a provisional obviousness-type double patenting rejection.

17. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 09/742,624 (refer to US 2001/0004001 for claims) in view of the collective teachings of Howey '682 and Ozawa.

With respect to claim 1, the copending application teaches all the limitations except the cartridge being a disc cartridge, supplying the liner to each half body section of the cartridge, and the liner having a cut-out aligned with an opening in the half body section.

It would have been obvious to have the cartridge of the copending application be used as a disc cartridge wherein the cartridge and liner are constructed and assembled in the manner claimed by the present invention because such is known in the art, as taught by the collective teachings of Howey and Ozawa, wherein this provides for a well-protected magnetic disc.

This is a provisional obviousness-type double patenting rejection.

18. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 09/742,624 in view of the collective teachings of Howey '682 and Ozawa and further in view of Kunio.

Regarding claim 2, the copending application is silent as to fusing the entire surface of the liner to the half body section. The skilled artisan would have been motivated to do so because such is known in the art, as taught by Kunio, wherein this prevents the liner from becoming detached from the half body section.

This is a provisional obviousness-type double patenting rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419 (571-272-1223 come mid December)**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi
Patent Examiner
Art Unit 1733



JEFF H. AFTERGUT
PRIMARY EXAMINER
GROUP 1300